

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte DENYS DENNEY and JOSE D. M. CONTRERAS

Appeal No. 2002-0037
Application No. 08/899,292

ON BRIEF

Before ABRAMS, FRANKFORT, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 5 and 10 to 22, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to an apparatus for shaping a slab of cellular polymer material by cutting and removing portions of the material from an outer surface of the slab. A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

Claims 1 to 5 and 10 to 22 stand rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 795,359 to Moore.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the final rejection (Paper No. 17, mailed May 23, 2000) and the answer (Paper No. 25, mailed April 11, 2001) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 24, filed January 25, 2001) and reply brief (Paper No. 26, filed June 13, 2001) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. Upon evaluation of

all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1 to 5 and 10 to 22 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

In the final rejection (p. 3), the examiner (1) set forth the teachings of Moore; (2) ascertained that the only difference between Moore and the subject matter of claims 1 and 12 (the independent claims on appeal) was that Moore lacked a drive roller for driving Moore's pattern m; and (3) determined it would have been obvious to one having ordinary skill in the art as a matter of common sense to provide a drive roller for Moore's pattern to reduce the drag of the pattern through the apparatus and thus

reduce the chance of slippage between Moore's rolls and the pattern as well as reduce the load on the rolls.

In the answer (pp. 3-4), the examiner (1) set forth the teachings of Moore; (2) ascertained that the only difference between Moore and the subject matter of claims 1 and 12 was that Moore lacked a drive roller for driving Moore's pattern m; (3) took Official Notice that drive rollers to drive endless belts are old and well known in the art; and (4) determined it would have been obvious to one having ordinary skill in the art as a matter of common sense to provide a drive roller for Moore's pattern for the well known benefits including to reduce the drag of the pattern through the apparatus and thus reduce the chance of slippage between Moore's rolls and the pattern as well as reduce the load on the rolls.¹

The appellants argue that the applied prior art does not suggest the claimed subject matter. We agree. Specifically, the applied prior art does not suggest modifying Moore's apparatus to provide a drive roller to drive Moore's pattern. In that regard, while it may be old and well known in the art to have drive rollers drive endless belts, there is no teaching or suggestion as to why it would have been obvious at the

¹ 37 CFR § 1.193(a)(2) prohibits an examiner's answer from containing a new ground of rejection. The examiner's use of Official Notice for the first time in the rejection set forth in the answer may constitute a new ground of rejection prohibited by 37 CFR § 1.193(a)(2). However, the appellants have not raised this issue and we see no need, in this case, to have that issue decided.

time the invention was made to a person of ordinary skill in the art to have provided a drive roller to drive Moore's pattern. To supply this omission in the teachings of the applied prior art, the examiner made the above-noted determination that this difference would have been obvious to an artisan. However, this determination have not been supported by any evidence that would have led an artisan to arrive at the claimed invention.²

In our view, the only suggestion for modifying Moore in the manner proposed by the examiner to meet the above-noted drive roller limitation stems from hindsight knowledge derived from the appellants' own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). It follows that we cannot sustain the examiner's rejections of claims 1 to 5 and 10 to 22.

² In page 7 of the answer, the examiner stated that drive rollers for driving belts such as that disclosed by Moore (i.e., pattern m) are old and well known in the art, particularly in the art of leather splitting machines. First, we note that this statement of what is old and well in the art is different from that set forth in the rejection (answer, p. 3) and therefore not before us in this appeal. Second, if it is old and well known in the art to drive belts, such as Moore's pattern m, by drive rollers, then the examiner should consider finding such prior art and applying that prior art in combination with Moore. In making this suggestion, we are not inferring that the claimed subject matter would be suggested by the combined teachings of Moore and any newly applied prior art. For example, in this appeal we have reached no decision that Moore has "a predetermined gap" as claimed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 5 and 10 to 22 under 35 U.S.C. § 103 is reversed.

REVERSED

NEAL E. ABRAMS
Administrative Patent Judge

CHARLES E. FRANKFORT
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

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